



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| | | | | |
|--|-------------|----------------------|---------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/528,363 | 03/17/2000 | Mason Ng | 305976US91 | 4258 |
| 22850 | 7590 | 07/15/2009 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | LIN, KENNY S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2452 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 07/15/2009 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

| | | | |
|------------------------------|--------------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 09/528,363 | Applicant(s) NG ET AL. | |
| | Examiner Kenny S. Lin | Art Unit 2452 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 31-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 31-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8 and 31-46 are presented for examination. Claims 9-30 are canceled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/6/2009 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 and 31-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US Patent 6,138,146, and Pivowar et al (Pivowar), US 6,457,062.
5. Narasimhan, Moon and Pivowar were cited in the previous office action.

Art Unit: 2452

6. As per claims 1-2, Narasimhan taught the invention substantially as claimed including a method of forwarding email, comprising:

- a. examining start criteria, the start criteria being independent of email stored in an email datastore (col.1, lines 46-49, col.2, lines 3-6, col.5, lines 3-35; e.g. filter and forwarding parameters are independent of the stored email);
- b. determining whether the start criteria are met (col.5, lines 18-40); and
- c. obtaining new email events from the email datastore when the start criteria are met (col.4, lines 6-11, col.5, lines 37-40, 50-60, col.6, lines 3-6, 11-21, 40-56).
- d. forward information corresponding to the new email events via a computer network to a datastore associated with the server (col.4, lines 6-11, 44-54, col.5, lines 3-17, col.6, lines 11-21, 40-56).

7. Narasimhan did not specifically teach the method is instructed by an email forwarding engine downloaded from a server computer to a client personal computer and the steps of comparing the start criteria stored on the client personal computer with start criteria stored on the server; and synchronizing the start criteria stored on the client personal computer and the start criteria stored on the server when a difference is detected there between. However, it would have been obvious to download software and implement the system with an email forwarding application. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail

Art Unit: 2452

forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

8. Narasimhan and Moon did not specifically teach to provide start criteria for comparison with start criteria stored on the client personal computer, wherein the start criteria of the client personal computer is synchronized to the start criteria of the server when a difference is detected there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62).

9. As per claims 3-4, Narasimhan taught the claimed invention including a method of forwarding email, comprising:

- e. Establishing a communication channel between a server and with a client personal computer system (col.1, lines 40-43, col.2, lines 50-65, col.3, lines 39-44);
- f. Receiving information corresponding to new email events from the client computer system (col.4, lines 6-11, col.6, lines 11-21, 40-56); and
- g. Storing the information corresponding to the new email events in a datastore associated with the server (col.4, lines 6-11, 44-54, col.6, lines 11-21, 40-56),

10. Narasimhan further taught to determine whether start criteria are met, wherein the start criteria being independent of the information stored in the datastore (col.1, lines 46-49, col.2, lines 3-6, col.5, lines 3-35; e.g. filter and forwarding parameters are independent of the stored email). Narasimhan did not specifically teach the method is instructed by an email forwarding engine downloaded from a server computer system to a client personal computer and to forward the information to an appropriate client personal computer. However, it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

11. Narasimhan and Moon did not specifically teach to provide start criteria for comparison with start criteria stored on the client personal computer, wherein the start criteria of the client personal computer is synchronized to the start criteria of the server when a difference is detected there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing

Art Unit: 2452

information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62).

12. As per claims 5-6, Narasimhan taught the claimed invention including a method of forwarding email, comprising:

- h. Obtaining filter control data, the filter control data being independent of email data (col.1, lines 46-49, col.2, lines 3-6: filter and forwarding parameter is different from email messages);
- i. Examining the email data against the filter control data (col.5, lines 3-17);
- j. Determine the email data that will be forwarded based on the examination (col.5, lines 3-40);
- k. Selecting at least one transfer protocol for the email data based on the examination (col.5, lines 18-26, 37-49, col.6, lines 40-56, col.7, lines 39-45); and
- l. Forwarding the email data according to the at least one transfer protocol via a computer network to a datastore associated with the server (col.4, lines 44-54, col.6, lines 19-21, 40-56).

13. Narasimhan did not specifically teach the method is instructed by an email forwarding engine downloaded from a server computer system to a client personal computer and the steps of comparing the filter control data stored on the client personal computer with filter control data stored on the server at predetermined time intervals; and synchronizing the filter control data stored on the client personal computer to the filter control data stored on the server when a

Art Unit: 2452

difference is detected between there between. However, it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

14. Narasimhan and Moon did not specifically teach the steps of comparing the filter control data stored on the client personal computer with filter control data stored on the server at predetermined time intervals; and synchronizing the filter control data stored on the client personal computer to the filter control data stored on the server when a difference is detected between there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62). Narasimhan, Moon and Pivowar did not disclosed in detail that the synchronization is performed at predetermined time interval. However, the concept and advantage of triggering commands or events using pre-set interval is well known and expected in the art (for example, daily scheduled

Art Unit: 2452

virus scan, weekly meeting reminder prompting). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar and further schedule regulated times for synchronizing contents to maintain an updated set of information.

15. As per claims 7-8, Narasimhan taught the invention substantially as claimed including a method of forwarding email, comprising:

- m. Obtaining filter control data, the filter control data being independent of email data (col.1, lines 46-49, col.2, lines 3-6: filter and forwarding parameter is different from email messages);
- n. Examining email data against the filter control data (col.5, lines 3-17); and
- o. Determining based on the examination the email data that should not be forwarded (col.2, lines 3-6, col.5, lines 3-23);
- p. Generating receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18);
- q. Forwarding the receipt data via a computer network to a datastore associated with the server (col.4, lines 6-11, col.6, lines 11-21, 40-56).

16. Narasimhan did not specifically teach the method is instructed by a computer program downloaded from a server computer system to a client personal computer and to generate receipt data identifying the email data that should not be forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that should be forwarded (col.1, lines 46-51,

Art Unit: 2452

col.4, lines 6-11, col.6, lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be forwarded and it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29) and to identify the email data that should not be forwarded and send the email data that should not be forwarded back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block. Narasimhan and Moon did not specifically teach to compare the filter control data stored on the client personal computer with filter control data stored on the server at predetermined time intervals; and synchronizing the filter control data stored on the client personal computer to the filter control data stored on the server when a difference is detected there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-

Art Unit: 2452

62). Narasimhan, Moon and Pivowar did not disclosed in detail that the synchronization is performed at predetermined time interval. However, the concept and advantage of triggering commands or events using pre-set interval is well known and expected in the art (for example, daily scheduled virus scan, weekly meeting reminder prompting). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar and further schedule regulated times for synchronizing contents to maintain an updated set of information.

17. As per claims 31, 34, 37, 39, 41, 43 and 45-46, Moon further taught that the client personal computer is protected by a firewall (figure 1: 18; col.3, lines 61-63, col.4, lines 45-46).

18. As per claims 32, 35, 42 and 44, Narasimhan, Moon and Pivowar did not specifically teach that the downloaded software self-installs. However, the concept and advantage of self-installing programs is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar and further self-install the downloaded programs to reduce user intervention and provide user-friendly installation process of software.

19. As per claims 33, 36, 38 and 40, Narasimhan further disclosed that the email event includes emails (col.2, lines 1-3).

Response to Arguments

Art Unit: 2452

20. Applicant's arguments filed 1/6/2009 have been fully considered but they are not persuasive.

21. In the remark, applicant argued (1) Pivowar does not teach synchronizing the start criteria stored on the client personal computer and the start criteria stored on the server when a difference is detected there between.

22. Examiner traverse the argument:

As to point (1), Pivowar reference is only relied upon to show that the concept of synchronizing data when a difference is detected is well known and combinable with Narasimham for synchronizing start criteria. Narasimham reference discloses the use of start criteria. Although Pivowar uses identification codes to keep track of the correspondence between the personal data store on the PDA and the server data stored on the server, the identification codes reflects to what is stored on PDA or server and indications of the difference of data when compared (see col.6, lines 5-10). Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62).

Art Unit: 2452

Conclusion

23. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kenny S Lin/
Primary Examiner, Art Unit 2152
July 13, 2009